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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/624,191	07/24/2000	Mark Donner	06975-100001	6404

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EXAMINER
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EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 07/16/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/624,191

Applicant(s)

DONNER ET AL.

Examiner

Hussein A El-chanti

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "105", "305", "405", "505" and "605" have both used to designate client system; reference characters "125", "325", "425", "555" and "655" have been used to designate client controller; reference characters "120", "320", "420", "520" and "620" have been used to designate client device; reference characters "150", "350", "450", "550" and "650" have been used to designate communication pathways; reference characters "110" and "210" have both been used to designate host system; reference characters "135" and "235" have both been used to designate host device; reference characters "140" and "240" have both been used to designate host controller; and reference characters "150" and "255" have both been used to designate communication pathways. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12, 17, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 12 recites the limitation "the remote server" in the third line of the claim and recites the limitation "the client" in the last line of the claim; claim 17 recites the limitation "the remote server" in the third line of the claim and recites the limitation "the client" in the last line of the claim; claim 19 recites the limitation of "the browser" in the claim.

There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 6-17 and 20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gottlieb.

As per claims 1 and 17, Gottlieb teaches alerting a client of a state of change at a remote sever comprising: creating a user profile indicating preference to receive at least one alert corresponding to a change in state at the remote server (see abstract and col. 2 lines 62-67); connecting to communications system including the remote server (see col. 3 lines 1-5); generating an address of the remote server (see col. 4 lines 10-14); navigating to the address of the remote server (see col. 4 lines 10-14); retrieving data corresponding to a particular type of alert from the remote serve (see col. 4 lines 6-8); and using the retrieved data in delivering an alert to the client (see col. 4 lines 15-18).

As per claims 2 and 3, Gottlieb teaches communication system comprises an instant messaging system (see col. 6 lines 43-48) and address comprises a uniform resource locator (see col. 4 lines 10-15).

As per claims 6 and 20, Gottlieb teaches using a graphical user interface to create the user profile (see col. 2 lines 61-67).

As per claims 7-11, Gottlieb teaches storing the user profile on a host (see col. 2 lines 61-63) where Gottlieb's configurations are stored in the computer program that resides in the personal computer, which is the host. Gottlieb also teaches the alert corresponds to a change at a remote mail server (see abstract) or a change at a remote weather server (see claim 12) or a change at a remote stock server (see abstract) or a change at a remote third party server (see abstract).

As per claims 12, Gottlieb teaches a computer program stored on a computer readable medium (see claim 1 and col. 2 30-33) comprising instructions for: creating a user profile indicating preference to receive at least one alert corresponding to a change in state at the remote server (see abstract and col. 2 lines 62-67); connecting to communications system including the remote server (see col. 3 lines 1-5); generating an address of the remote server (see col. 4 lines 10-14); navigating to the address of the remote server (see col. 4 lines 10-14); retrieving data corresponding to a particular type of alert from the remote serve (see col. 4 lines 6-8); and using the retrieved data in delivering an alert to the client (see col. 4 lines 15-18).

As per claims 13-16, Gottlieb teaches a computer readable medium comprising a disc (see col. 2 lines 30-32), computer readable medium comprising a client device (see

col. 4 lines 15-18) where the client is the e-mail notification device, computer readable medium comprising a host device (see col. 2 lines 20-30) where the host device is the personal computer, computer readable medium comprising a propagated signal (see col. 2 lines 30-33) where the propagated signal is a magnet-optical media.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 5, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gottlieb in view of Killcommons et al.

As per claims 4 and 18, Gottlieb teaches all the limitations of claim 1 and an instant messaging client (see col. 6 lines 43-48). Gottlieb doesn't teach navigating to the address includes using a browser embedded in an instant messaging client. However Killcommons et al teach an embedded browser that is used in file transfer using user interface to a display associated with a remote unit (see abstract lines 15-21). One of the ordinary skills in the art at the time of the invention would use Gottlieb's alerting system over Killcommons et al's embedded browser to alert a client of a change in a remote host while using the instant messaging system.

As per claims 5 and 19, Gottlieb also teaches the browser comprises a HTTP engine (see col. 4 lines 10-15).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

H.E.



**SALEH NAJJAR  
PRIMARY EXAMINER**